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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,013	10/04/1999	Jonas Lowell Steinman	10153-003	9120

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/412,013

Applicant(s)

STEINMAN ET AL.

Examiner

Raquel Alvarez

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to communication filed on 6/3/02. Claims 1-70 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-70 rejected under 35 U.S.C. 103(a) as being unpatentable over Storey (5,774,870 hereinafter Storey) in view of article titled "Sportsline USA. Reports Fourth Quarter Financial Results" (hereinafter Sportsline).

With respect to claims 1-2, 16, 18-19, 33, 35-36, 50, 52, 53, 60-62, Storey teaches a host computer system hosting a webpage (figure 1) wherein the webpage includes a plurality of links and each of the plurality of links has an associated point value (i.e. PRODUCT A HOMEPAGE, 100A, may be a homepage for men's shirts. In such an example, the PRODUCT A HOMEPAGE, 100A, may include icons to allow the user to select information regarding, for example, different brands, price ranges, types (dress shirts, sport shirts, etc.), and thereafter review the products available relating to the particular selection, the particular products having an associated award point value) ; wherein the host computer system awards at least one point to a user when the user clicks on one or more plurality of links (i.e. the user is awarded points based on the particular product ordered, the particular product ordered

representing a selection of a product. The particular product ordered representing a selection of a product (col.3, lines 62-, col. 6, lines 1-6).

Storey does not specifically teach that the points are awarded can be used for entries in a sweepstake. On the other hand, Sportsline teaches a program wherein members earn and wherein the points can be used to earn sweepstake entries to a \$1 million cash prize for viewing pages on CBS Sportsline (page 3, 1st paragraph). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included awarding entry to a sweepstake based on the points awarded because such a modification would motivate the user to increase his or her activities at the website.

Claims 3, 13, 20, 30, 37, 47, 54, 57-59, 63, 67 further recite storing registration information pertaining to the user, such as point information relating to the user. Official notice is taken that it is old and well known to store information in a database or the like for easier retrieval and access of the data. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included storing registration information or point information related to the user because such a modification would allow the system to keep user's information within easy access.

Claims 4-7, 9-12, 14-15, 21-24, 26-29, 31-32, 38-46, 48-49, 51, 55-56, 64-66, 68-69 are different implementation choices that can be implemented without major changes to the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included implementing the system as recited by

Art Unit: 3622

claims 4-7, 9-12, 14-15, 21-24, 26-29, 31-32, 38-46, 48-49, 51, 55-56, 64-66, 68-69 as designer's choices.

Claims 17, 34 and 70 are similar in scope as claims 16, 33 rejected above and therefore rejected under similar rationale.

With respect to claims 8 and 25, the combination of Storey and Sportsline do not specifically teach that one of the services is e-mail. E-mail is a common service offered in the on-line world. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included e-mail as one of the services offered.

Response to Arguments

3. Applicant's arguments filed 6/3/02 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., where the bonus points are provided for activities other than making purchases) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims do not specifically disclose any activities that must be included or excluded after the click in order to allow the users to receive award points. Storey teaches that the user clicks on the products from the product's homepage to view the products that are available for purchase. In order to make purchases, **the user clicks** on the particular item's page

and from that particular page, the award levels will be determined based on the product's page selected (col. 3, lines 66-, col. 4, lines 1-10).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to Applicant's arguments of claims 52 and 61, the Applicant argues that Storey does not disclose a service that includes one or more features and that the features have associated point value. The Examiner asserts that products or merchandises are services that are provided to the client and that different point value are assigned to the different services or products (col. 3, lines 66-, col. 4, lines 1-10).

With respect to the arguments presented by the Applicant with respect to dependent claims 3, 13, 20, 30, 37, 47, 54, 57-59, 63 and 67, after carefully reviewing the Storey reference, the Examiner wants to point Applicant to column 4, lines 11-26 wherein it discloses that users are categorized based on certain set of requirements. Based on the user's activities they will be allow to participate in various incentive awards programs which means that the system is storing information pertaining to the users in order to be able to differentiate the different type of users and provide the incentive program accordingly.

With respect to Applicant's arguments to making a webpage a user's home page as reflected in 6, 23 and 40, the Examiner takes official notice that it is old and well

known in the computer related arts to include making a webpage a user's web page because such a modification would provide easier access to the information.

With respect to claims 9, 10, 12, 26, 27 and 29, the Applicant is arguing the displaying of points earned by a user. The Examiner has taken official notice that since the combination of Storey and CBS Sportline teach granting points to the user then the displaying would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention because such a modification would allow the user to view the points that have been earned.

With respect to Applicant's arguments to claims 17, 34 and 70, the Examiner wants to point out that the combination of Storey and CBS Sportline teach awarding points to a user's access to a website through a third party site (i.e. Storey teaches that the from the program home page 300 (third party), the user clicks on the product's home page 100A to view the products that are available for purchase. Different products having different award levels. The level of points based on the selection of the products.

With respect to the arguments to claims 8 and 25, the Examiner asserts that e-mail like services are products that are available to the customer for a fee and therefore would have been obvious to include e-mail as one of the products or services offered to the users who own a computer because such a modification would expand the services or products offered.

With respect to the official notice taken, an improper challenge to official notice notice was presented by the Applicant. A challenge to the taking of judicial notice must

contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice. **In re Boon** , 439 F.2d 724, 169 USPQ 231 (CCPA 1971).

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are

Application/Control Number: 09/412,013


Page 8

Art Unit: 3622

(703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

R.A.
8/15/02


MELANIE A. KEMPER
PRIMARY EXAMINER